

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 29 1997

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

R E C E I V E D

OCT 01 1997

Ex parte RHONDA TRACY

Appeal No. 95-3512  
Application 08/092,540<sup>1</sup>

COOK, MCFARRON & MANZO

HEARD: September 17, 1997

Before McCANDLISH, Senior Administrative Patent Judge, and STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 26 through 39 and 41, all of the claims pending in the application.

<sup>1</sup> Application for patent filed July 16, 1993. According to the appellant, the Application is a continuation of Application 07/790,469, filed November 12, 1991, now abandoned, which is a continuation of Application 07/516,473, filed April 30, 1990, now U.S. Patent No. 5,064,421, which is a continuation of Application 07/093,681, filed September 8, 1987, now abandoned.

EXHIBIT

No. 3

Tracy 09/107.643

Appeal No. 95-3512  
Application 08/092,540

The invention relates to "a disposable diaper having a padded waistband and legholes" (specification, page 1). Claim 26 is illustrative and reads as follows:

26. A disposable diaper comprising:

a body portion having two enlarged end portions and a narrowed intermediate portion therebetween, the body portion being shaped so that said diaper may extend about a waist and crotch of a wearer and have an inside and an outside with respect to the wearer;

each end portion having a respective waistband portion at an edge thereof so that when the diaper is worn, the waistband portions gird the waist of the wearer;

at least two body-portion layers including a layer of liquid-absorbent material and a plastic layer having an edge at the edge of the diaper;

a soft padding member located along at least one of said waistband portions, being adjacent to said plastic layer edge, the soft padding member being distinct from all of said body-portion layer, the soft padding member including a material formed from a soft substance presenting a soft surface along at least a portion of said inside of the diaper waistband portion despite said plastic layer edge.

The references relied upon by the examiner as evidence of obviousness are:

McConnell et al. (McConnell) Gilles	3,461,872 4,728,326	Aug. 19, 1969 Mar. 1, 1988 (filed Jan. 2, 1986)
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Claims 26 through 39 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gilles in view of McConnell.

Gilles discloses an adjustable diaper 10 having a body portion 12. As described in the reference,

[t]he body portion has a relatively narrow central portion 22 formed by gathers 24 and 26 prior to stitching at 28 and 30 near the sides 14 and 16. This produces a concave interior for a better fit. The body portion also has a front part 34 generally adjacent front end 18 and a back part 32 generally adjacent back end 20.

The body portion is made of a flexible sheet-like material, preferably cotton flannelette. Two layers of fabric 36 and 38 are used as seen in FIG. 4. Internally, additional somewhat trapezoidal-shaped layers of fabric are used for absorbency purposes. These are sandwiched together as seen in FIG. 4. The outer layers 40, 42, 44 and 46 extend from the central portion 22 into the back part 32 and the front part 34. Two additional layers 48 and 50 occur between layers 42 and 44 and extend from the central portion into the front part. The layers 40-50 are held in position between layers 36 and 38 by stitching 52 shown in FIG. 3.

The sides of the body portion are finished by cloth strips 54 and 56 folded over the edges and sewn in place by stitching 30 and 28 shown in FIG. 4. The use of gathers 24 and 26 in combination with cloth strips 54 and 56 and stitching 30 and 28 provides a more comfortable fit than the elastic portions used in prior art fitted diapers. FIG. 5 shows strip 54 in section. At front end 18 [a] layer of cloth 38 is folded over to form a portion 62 overlaying layer 36 and held in position by stitching 64.

At back end 20 the diaper has a pair of strap members 66 and 68 which form outer extensions of a waist band 70. As seen best in FIGS. 3, 4 and 6, the waist band 70 is formed of a single strip of cloth folded and with stitching 72 and 74 extending along opposite sides thereof [column 2, lines 29 through 62].

McConnell discloses a diaper retaining garment "for retaining a diaper, generally of the disposable type, in position adjacent the perineal region of a wearer" (column 1, lines 21 through 28). The garment consists of a generally rectangular sheet of flexible polymeric cellular material having snap fasteners secured at its four corners. Folded about the side and end edges of the sheet are an elastic strip 21 and an overlying outer strip 22 which is preferably made of a woven fabric or scrim. The purpose of the outer strip 22 is "to prevent contact of the wearer with the elastic material forming strip 21" (column 3, lines 32 and 33).

In explaining the rejection on appeal, the examiner states that:

Gilles discloses the invention substantially as claimed with at least two body portion layers (42, 44, 46, 48, and 50) that include a liquid absorbent layer and soft absorbent padding members (54, 56, and 70) formed of cloth along the leg portions and at least one of the waistband portions, however, Gilles does not teach the padding at the waistband to extend around from the inside to the outside and one of the layers to include plastic.

McConnell teaches it is old and well known within the art to those of ordinary skill in that art to provide padding (22) that is of absorbent cloth extending around from the inside to the outside of the waistband (lines 30-39 of column 3).

As to the plastic limitation, whether one of the layers is plastic or one of the materials taught by Gilles is considered an obvious matter of design choice to one of ordinary skill within the art as determined by what material is considered most appropriate for the article and in view of the fact that the inventive concept of shielding the wearer from discomfort from rough edges is not a function of the material in the layers.

It would have been obvious to said artisan to modify Gilles per the above cited teachings of McConnell to provide a waistband that feels more comfortable to the wearer [final rejection, Paper No. 19, pages 3 and 4].

Claims 26, 34 and 41, the three independent claims on appeal, recite with varying degrees of specificity a disposable diaper comprising, inter alia, a plastic layer or material at or extending to a waistband edge of the diaper and an associated soft padding member. More particularly, claim 26 requires "a plastic layer having an edge at the edge of the diaper" and "a soft padding member located along at least one of said waistband portions, being adjacent to said plastic layer edge . . . including a material formed from a soft substance presenting a soft surface along at least a portion of said inside of the diaper waistband portion despite said plastic layer edge." Claim 34 sets forth "a plastic material extending to an edge of the body portion [of the diaper]" and "a first soft padding member . . . including a strip of a soft substance located along at

Appeal No. 95-3512  
Application 08/092,540

least one of said waistband portions . . . to present a soft surface at said inside of the diaper waistband despite the plastic material at the edge of the body portion." Claim 41 calls for the waist band to include "plastic material at border edges thereof" and "a padding member extending along an opposite edge portion at an exposed surface of the waist band . . . including at least one strip of material formed from a soft substance . . . forming a soft surface for contact with the skin of the individual at least one of the border edges."

As indicated above, the examiner concedes that the Gilles diaper does not meet the noted limitations in claims 26, 34 and 41 relating to the plastic layer or material. In this regard, the Gilles diaper is made essentially of cloth fabric and is not disclosed as containing any plastic layer or material of the sort required by the claims. The examiner's conclusion that it would have been an obvious matter of design choice to provide the Gilles diaper with such a plastic layer or material is not well founded.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may

not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id. Here, the examiner has failed to supply any factual basis to support the conclusion that the provision of a plastic layer or material as recited in the claims to the Gilles diaper would have been an obvious matter of design choice. Indeed, the cloth fabric construction of the Gilles diaper would appear to teach away from the proposed modification. The diaper retaining garment disclosed by McConnell is of no help to the examiner in this regard. Thus, it is evident that the examiner has resorted to speculation, unfounded assumptions and/or hindsight reconstruction to supply the acknowledged deficiency in the prior art basis for the appealed rejection.

The combined teachings of Gilles and McConnell also would not have suggested a diaper having a soft padding member as recited in independent claims 26, 34 and 41. Although both the Gilles diaper and McConnell diaper retaining garment include cloth or fabric border strips, there is nothing in these references to indicate that such strips constitute soft padding members as alleged by the examiner.

Appeal No. 95-3512  
Application 08/092,540

For these reasons, the combined teachings of Gilles and McConnell do not justify the examiner's conclusion that the subject matter recited in independent claims 26, 34 and 41 would have been obvious to one of ordinary skill in the art. Therefore, we shall not sustain the standing 35 U.S.C. § 103 rejection of these claims or of claims 27 through 33 and 35 through 39 which depend therefrom.

As a final matter, it is noted that the claims in parent Application 07/790,469 were subjected to an obviousness-type double patenting rejection based on U.S. Patent No. 5,064,421, and that such rejection was overcome by a terminal disclaimer (Paper No. 6). Given its terms, the terminal disclaimer would not appear to be effective with respect to the instant application (see MPEP 1490). Since the claims on appeal are of a scope which is similar to that of the claims which were rejected in the parent application, the examiner my wish to consider whether the claims on appeal raise an obviousness-type double patenting issue which can be obviated by the filing of a new terminal disclaimer.

Appeal No. 95-3512  
Application 08/092,540

In any event and for the above reasons, the decision of the examiner to reject claims 26 through 39 and 41 under 35 U.S.C. § 103 as being unpatentable over Gilles in view of McConnell is reversed.

REVERSED

*Harrison E. McCandlish*  
HARRISON E. McCANDLISH, Senior )  
Administrative Patent Judge )  
)  
*Lawrence J. Staab*  
LAWRENCE J. STAAB )  
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Appeal No. 95-3512  
Application 08/092,540

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